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PATENT TRADEMARK OFFICE

Docket No: 9386/1F051-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Albhy Galuten et al.

Serial No. 09/471,971

Art Unit: 3625

Confirmation No.: 8165

Filed: December 23, 1999

Examiner: Robert M. POND

For: **ELECTRONIC MUSIC/MEDIA DISTRIBUTION SYSTEM**

DECLARATION UNDER 37 C.F.R. § 1.131

Hon. Assistant Commissioner of
Patents and Trademarks
Washington, DC 20231

February 21, 2003

Sir:

Albhy GALUTEN, Dmitry RADBEL & Peter WILLIAMS being duly sworn, depose and say:

1. We are inventors of the patent application identified above and we are the inventors of the subject matter described and claimed therein.

2. Prior to August 13, 1998, the effective date of the Downs reference (U.S. Patent No. 6,226,618) and the BW Article, we had completed our invention as described and claimed in the subject application in this country, a NAFTA country, or a WTO member country. Our invention was conceived in full, and due diligence was used to reduce it to practice, for example by filing this patent application. As evidence that our work antedates Downs, we refer to the Preliminary High-Level Description of the Electronic Music Distribution System, Document 1.1, Version 0.020, attached hereto as Exhibit 1. Document 1.1 is an in-house specification. Dates and certain other proprietary disclosures appearing in this document have been redacted. We declare that this document (Exhibit 1) was created before August 13, 1998.

3. Claims 3-88 are pending in our application. With respect to the subject matter of claims 3-88, our Document 1.1 discloses a secure digital and electronic content delivery system, method, and a computer readable medium for distributing content to a user. The distributed content is selected via lists, catalogs or in response to promotional offers to the retail web modules and sites. The distribution of audio programs and multi-media video or other types of content is also disclosed. See at least pages 9-12, including diagrams 1 and 2. These early descriptions provide the methods and structures of the presently claimed invention.

4. Additionally, pages 17-19 disclose each of the claimed system embodiments with particularity. These systems include the retail web sites, the content catalog, the reference service, the electronic clearinghouse services, and the content consumer. Pages 29 and 30 of Document 1.1 are marked as Appendix A, and also shows the claimed invention. Appendix A describes a pilot program and all of the pieces needed to make and use the current invention. See, e.g., claims 3-37, 42-76, 81 and 83.

5. Figure 1 located on page 9 discloses a consumer browsing to a Retail web site. The Retail web site transmits an Offer to a Production system. Next, the offer is transmitted to a Delivery System and then is sent to the consumer. Next, the consumer sends pay information to the Electronic Clearinghouse Services, which then leads to the content being sent by the Delivery Service to the consumer. Further, on page 10, Retail Web Sites are defined as “web sites of the music retailers...[t]hey provide retail commercial offers (rights) for the EMD content and can be accessed by consumers”. Additionally, “Retailers... add... commercial business rules... for the consumption of the content.” The Reference Service is defined as “help[ing] customers to purchase the content by linking it with valid commercial offers.” Additionally, the Delivery Service “downloads the actual content... to consumer devices.” See, e.g., claims 3-37, 42-76, 81, and 83.

6. These descriptions provide a method and system for distributing electronic information, as in the pending claims of our application. A consumer request for selected information is received, an offer associated with the selected information is made, based on the rules, and the information is delivered when an offer is accepted. See independent claims 3, 38, 42, 77, 81, and 83.

7. The text on pages 24 and 25 of Document 1.1 disclose sending a content reference from one consumer to another. The first full paragraph on page 25 clearly defines a typical single consumer transaction. This includes the fact that if the consumer is interested in a product, defined as the content plus the offer, the consumer will receive a specific HTML Reference. In the paragraph prior, starting on the bottom of page 24, it was clearly conceived

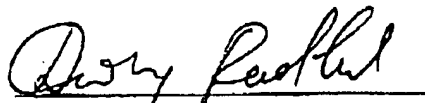
that the users would be able to send content information between users. The embodiment stated utilizes e-mail. See, e.g., claims 38-41, 77-80, 82 and 84.

8. Again, Document 1.1 describes a method and system according to the invention. This description provides a method allowing one consumer to transmit a content reference to another user. The second user then requests the content and it is determined if the second user is authorized to access the content. Lastly, once it is determined that the user is authorized, the information is transmitted to the user. This description was made before August 13, 1998 and antedates the Downs and BW Article references.

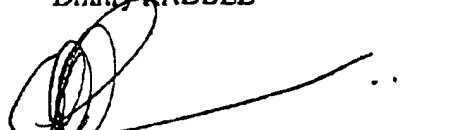
9. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Abby GALUTEN

2-25-03
Dated


Dmitry RABDEL

2/25/03
Dated


Peter WILLIAMS

2/26/03
Dated